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In re Application of: :
Eggert Stockfleth :
Serial No.: 10/574,422 : PETITION DECISION
Filed: November 7, 2006 :
Attorney Docket No.: 50125/084002 :

This is in response to the petition under 37 CFR § 1.181, filed February 21, 2008, requesting that the finality of the Office action of December 18, 2007 be withdrawn.

BACKGROUND

More recently, the examiner mailed a non-final Office action on July 6, 2007 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 1-35 were pending and claims 33 and 34 were withdrawn from examination on the merits as being directed toward a non-elected invention, leaving claims 1-32 and 35 for examination on their merits.

In this non-final Office action, the examiner instituted the following rejections:

- 1) Claims 1, 3-5, and 8-20, and 27 under 35 USC § 102 (a) as being anticipated by Dou et al (US 2002/0151582),
- 2) Claims 1-3, 6, 8-20, 27, 29, 30, and 35 under 35 USC § 102 (a) as being anticipated by Evans et al (US 2003/0143165),
- 3) Claims 1-6, 8-20, and 29 under 35 USC § 102 (b) as being anticipated by Zhao et al (1998),
- 4) Claims 1, 3-5, 8-20, and 27-30 under 35 USC § 102 (b) as being anticipated by Hersh et al (US 6,337,320),
- 5) Claims 1, 3-5, and 7-27 under 35 U.S.C. 103(a) as being unpatentable over Dou et al (US 2002/0151582),
- 6) Claims 1-3, 6, 8-27, 29, 30, and 35 under 35 U.S.C. 103(a) as being unpatentable over Evans et al (US 2003/0143165),
- 7) Claims 1-6, 8-27, and 29 under 35 U.S.C. 103(a) as being unpatentable over Zhao et al (1998),
- 8) Claims 1, 3-5, 8-20, and 27-30 under 35 U.S.C. 103(a) as being unpatentable over Hersh et al (US 6,337,320),
- 9) Claims 1, 3-5, 7-27, 31, and 32 under 35 U.S.C. 103(a) as being unpatentable over Dou et al (US 2002/0151582) in view of Sheffield, SR (US 2002/0031535), and

10) Claims 1, 3-5, and 7-27 under 35 U.S.C. 103(a) as being unpatentable over Dou et al (US 2002/0151582).

Applicant filed arguments and amendments to the claims on October 9, 2007 in response to the non-final Office action of July 6, 2007.

On December 18, 2007, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 1, 3-6, and 8-35 were pending and claims 33 and 34 remained withdrawn from examination on the merits, being directed toward a non-elected invention. Claims 1, 3-6, 8-32, and 35 remained eligible for examination on their merits.

In this final Office action, the examiner instituted the following rejections:

- A) Claims 1, 3-6, 8-20, 27, and 29 under 35 USC § 102 (a) as being anticipated by newly applied Li et al (1999) as evidenced by Dou et al (US 2002/0151582),
- B) Claims 1, 3-6, and 8-20 under 35 USC § 102 (b) as being anticipated by newly applied Jia et al (2002),
- C) Claims 1, 3-6, 8-27, and 29 under 35 U.S.C. 103(a) as being unpatentable over newly applied Li et al (1999) as evidenced by Dou et al (US 2002/0151582),
- D) Claims 1, 3-6, and 8-26 under 35 U.S.C. 103(a) as being unpatentable over newly applied Jia et al (2002),
- E) Claims 1, 3-6, 8-32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over newly applied Li et al. (1999) in view of Brash et al (US 2002/0198161), and further in view of Voet (US 6,723,750), as evidenced by Dou et al (US 2002/0151582),
- F) Claims 1, 3-6, 8-28, 30-32, and 35 under 35 U.S.C. 103(a) as being unpatentable over newly applied Jia et al (2002) , and further in view of Voet (US 6,723,750), as evidenced by Dou et al (US 2002/0151582).

In response thereto, applicant filed this petition on February 21, 2008, requesting that the finality of the Office action of December 18, 2007 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In this petition filed on February 21, 2008, applicant argues that the final Office action mailed on December 18, 2007 was premature and improper. Specifically, applicant contends that all of the rejections made in the final Office action, represented by A-F, above, were new grounds of rejection, not necessitated by applicant's amendments to the claims filed on October 9, 2007.

Specifically, applicants indicate that the amendment filed on October 9, 2007 merely added the limitation of 'pre-cancerous' from claim 2 into claim 1 and subsequently cancelled claim 2, among other amendments to the claims. Applicant argues that "...nothing in the amendments to the claims in response to the first Office action changed the scope of the claims in such a way as to make the newly cited references applicable to the currently pending claims, but not to the claims as originally filed" (p. 3, Petition). Applicant thus asserts that the new rejections made in the final Office action, represented by A-F above, were new rejections, not necessitated by applicant's amendments to the claimed invention.

Applicant, in support of his arguments refers to MPEP § 706.07:

'...the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection....Switching... from one set of references to another by the examiner in rejecting successive actions claims of substantially the same subject matter will... tend to defeat attaining the goal of reaching a clearly defined issue for an early termination.....applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in prosecution of his or her application...a second... action on the merits in any application..., should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed' (emphasis added)

Applicant's points are well taken. It is clear that claim 1 was amended by applicant on October 9, 2007 merely to add the limitation of 'pre' to the previously existing limitation of 'cancerous' to claim 1, wherein the term 'pre-cancerous' was already present in claim 2, which had already been considered by the examiner in the non-final Office action. Thus, the new rejections presented by the examiner in the final rejection over claim 1 and claims dependant therefrom, in which the examiner explicitly states that each new rejection was necessitated by applicant's amendments to the claims, were indeed *not* necessitated by applicant's amendments as it is clear that the term 'pre-cancerous' was present in claim 2 prior to the amendment of the claims by applicant on October 9, 2007. Thus, any applicable art pertaining to claim 2 such as Li et al. (1999) or Jia et al (2002) (*inter alia*) should have been applied over claim 2 or any other applicable claims at the time of the non-final Office action.

It is thus decided that the final Office action mailed on December 18, 2007 was premature and not in accord with MPEP § 706.07. All of the rejections set forth in the final Office action identified as A-F above were new grounds of rejection not necessitated by an amendment or any IDS submitted by applicants. Accordingly, applicant has not been provided a fair chance to rebut these new rejections and develop a clear record prior to any appeal.

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in black ink, appearing to read 'B. Kisliuk', with a stylized flourish at the end.

Bruce Kisliuk
Director, Technology Center 1600